

## REMARKS

In an Office Action mailed on April 14, 2005, claims 28-36 and 38-45 were rejected under 35 U.S.C. § 102(b) as being anticipated by Winter; claims 28, 29 and 38-40 were rejected under 35 U.S.C. § 102(f) in view of U.S. Patent Application Serial No. 10/449,496; claims 37 and 36 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Winter; claims 28 and 38 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting over U.S. Patent Application Serial No. 09/970,353; and claims 28, 38 and 39 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2 and 40 of U.S. Patent Application Serial No. 10/449,496.

The Office Action refers to "U.S. Patent Application Serial No. 10/449,496" in the § 102(f) and double patenting rejections. Because applicant does not own this application, it is assumed that the serial number reference in the Office Action is incorrect and should instead be "U.S. Patent Application Serial No. 10/449,469" (herein called the "'469 patent application"). Terminal disclaimers are being submitted herewith to overcome the provisional double patenting rejections. The §§ 102 and 103 rejections are addressed below.

### §§ 102 and 103 Rejections of Claims 28-37:

The apparatus of independent claim 28 includes a weld coupling that is adapted to be welded to an outer housing of a first cable segment to couple the first cable segment to a second cable segment. The apparatus also includes a thermal insulator that is adapted to prevent thermal damage to a communication line of the first cable segment when the weld coupling is welded to the outer housing.

Claim 28 stands rejected under 35 U.S.C. § 102(b) as being anticipated by Winter. In this rejection the Examiner contends that the outer sleeve 46 of Winter allegedly discloses the weld coupling of claim 28, and the ferrule 30 of Winter allegedly discloses the thermal insulator of claim 28. However, contrary to this labeling, Applicant submits that the ferrule 30 does not constitute the thermal insulator of claim 28 for at least the following reasons.

Winter mentions that the ferrule 30 may be metallic in that the ferrule 30 is intended to possess a tensile strength that is greater than the tensile strength of the material forming the tubes 16, and the ferrule 30 is to possess electrical conductivity properties. Furthermore, in order to

join the tubes 16 together by a solder or other metallic seam, the ferrule 30 would have to be metallic, in that each tube 16 would be soldered to one end of the ferrule 30 to permit the ferrule 30 to couple the tubes 16 together. *See, for example*, Winter, 8:55-65 and Fig. 6 of Winter.

Thus, if the outer sleeve 46 is considered the weld coupling of independent claim 28, the ferrule 30 must be metallic, as the ferrule 30 would be welded to the tubes 16 when the outer sleeve 46 is welded to the ferrule 30. However, this arrangement is inconsistent with the ferrule 30 being a thermal insulator. More specifically, if the ferrule 30 is metallic and soldered to the tubes 16, the ferrule 30 would conduct heat and be at approximately the same temperature as the tubes 16 during the welding. Thus, in such an arrangement, the ferrule 30 serves as a *thermal conductor*, not a thermal insulator, and would *conduct the heat closer to the optical fibers 14* (*emphasis added*). Therefore, for at least the reason that Winter fails to disclose the thermal insulator of claim 28, Winter fails to anticipate this claim.

Independent claim 28 also stands rejected under 35 U.S.C. § 102(f) because the Applicant allegedly did not invent the claimed subject matter. The Examiner bases the § 102(f) rejection of claim 28 on claims 1 and 2 of the '469 patent application.

However, the Examiner fails to establish a *prima facie* § 102(f) rejection for claim 28 for at least the following reasons. First, the named inventors on a particular patent application are the inventors for the entire set of claims that are contained in the application, as the naming of an inventor on an application means that the inventor contributed to at least one claim, not necessarily all of the claims or the broadest claims. Thus, by only considering the named inventors for instant application and the '469 patent applications, the Examiner is drawing an unsupported conclusion as to the inventors for claim 28 of the instant application and claims 1 and 2 of the '469 patent application. Therefore, for at least this reason alone, a *prima facie* § 102(f) rejection for claim 28 has not been established.

The Examiner fails to establish a *prima facie* § 102(f) rejection for claim 28 for at least the additional, independent reason that the claim 28 has a different scope than either claim 1 or 2 of the '469 patent application. For example, claim 1 of the '469 patent application recites at least one reflective sleeve, and claim 28 of the instant application recites a thermal insulator. One skilled in the art would appreciate that these two elements have different scopes. Thus, the reflective sleeve, if arguably considered to be covered by the broader genus "thermal insulator,"

is a species of the thermal insulator if not outside its scope altogether. The mere mention in claim 2 of the '469 patent application that the reflective sleeve prevents thermal damage does not necessarily make the reflective sleeve a thermal insulator, and even if such protection does mean the reflective sleeve is a thermal insulator, a reflective sleeve is not the only possible species of a thermal insulator. Therefore, because the claims of the two applications are directed to different inventions, a *prima facie* § 102(f) rejection has not been established. As such, for at least this additional, independent reason, withdrawal of the § 102(f) rejection of independent claim 28 is requested.

Claims 29-37 overcome the §§ 102 and 103 rejections for at least the same reasons as independent claim 28.

#### §§ 102 and 103 Rejections of Claims 38-46:

As amended, the method of independent claim 38 includes providing a weld coupling that is adapted to be welded to a first cable segment and a second cable segment to couple the first and second cable segments together. The method includes preventing thermal damage to a communication line of the first cable segment when the weld coupling is welded to at least one of the first cable segment and the second cable segment.

Winter fails to anticipate independent claim 38 for at least the reason that Winter fails to disclose prevention of thermal damage to a communication line when a weld coupling is welded to a cable segment. See discussion of independent claim 28 above. In particular, Winter discloses welding the ferrule 30 (i.e., the alleged thermal insulator) to the tubes 16 and thus, in effect, discloses using the ferrule 30 to conduct heat closer to the optical fibers 14 instead of preventing thermal damage to the optical fibers 14. Therefore, Winter fails to disclose the act of preventing of independent claim 38; and for at least this reason, Winter fails to anticipate this claim.

Independent claim 38 also stands rejected under 35 U.S.C. § 102(f) in view of the '469 patent application. See discussion of independent claim 28 above. In particular, a *prima facie* § 102(f) rejection has not been established for at least the reason that the Examiner concludes inventorship of claim 38 of the instant application is incorrect in view of claim 1 of the '469 patent application without any document specifying the inventors for the specific claims.

Additionally, the elements "thermal insulator" and "reflective sleeve" have differing scopes, and thus, the claims of these two applications are directed to different inventions. Therefore, for at least any of these reasons, withdrawal of the § 102(f) rejection of independent claim 38 is requested.

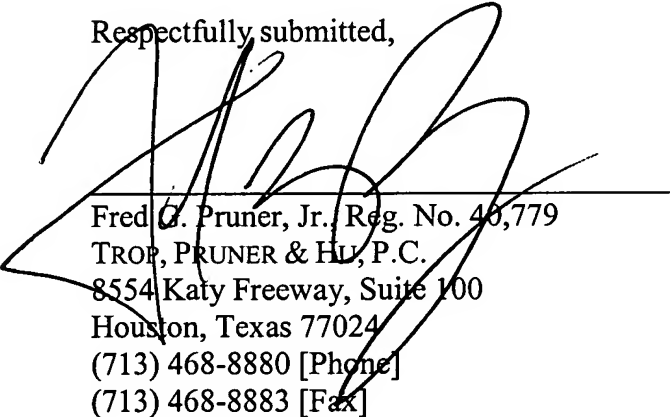
Claims 39-46 overcome the §§ 102 and 103 rejections for at least the same reasons as independent claim 38.

#### CONCLUSION

In view of the foregoing, withdrawal of the double patenting, §§ 102 and 103 rejections and a favorable action in the form of a Notice of Allowance are requested. The Commissioner is authorized to charge any additional fees or credit any overpayment to Deposit Account No. 20-1504 (SHL.0231C1US)

Respectfully submitted,

Date: July 14, 2005



Fred G. Pruner, Jr., Reg. No. 46,779  
TROP, PRUNER & HU, P.C.  
8554 Katy Freeway, Suite 100  
Houston, Texas 77024  
(713) 468-8880 [Phone]  
(713) 468-8883 [Fax]